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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/014,112

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Harold Aaron Ludtke

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EXAMINER

KUCAB, JAMIE R

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

02/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/014,112	Applicant(s) LUDTKE ET AL.	
	Examiner JAMIE KUCAB	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-10,12,14,109-114 and 116-123 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8-10, 12, 14, 109-114, and 116-123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office action is in response to the RCE filed on October 22, 2007.
2. The amendment filed October 22, 2007 is acknowledged.
3. This Office action is given Paper No. 20080130 for reference purposes only.
4. Based on a comparison of the PGPub US 2002/0128980 A1 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary, any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 22, 2007 has been entered.
6. Claims 1, 2, 8-10, 12, 14, 109-114, and 116-123 are currently pending.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 8-10, 12, 14, 109-114, and 116-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124 in view of Shinn, U.S. Patent No. 6,655,585.

9. As per claims 1, 2, 8-10, 12, 14, 109-114, and 116-123, Krishnan et al. teach a method and system for effecting a transaction between a person and a provider over a network comprising:

- establishing a communication link over said network between a communication device and said provider (figures 7 and 10);
- receiving, at said communication device from said provider, an order form for carrying out a transaction based on the at least one selection (column 21, lines 15-21);
- acquiring, at said communication device, at least one selection provided by the person (column 21, lines 15-21);
- transmitting (using a computer and the internet), from said communication device to said provider, the at least one selection (column 21, lines 15-21);
- if the generated unique identification trait substantially matches one of the plurality of stored unique identification traits,

- retrieving, from the database, a credit card number and personal information stored in association with the substantially matching one of the plurality of stored unique identification traits, the credit card number and the personal information being associated with the person (figure 17; column 19, lines 35-67; column 21, lines 15-21),
- completing, at said communication device, the received order form using the retrieved credit card number and the retrieved personal information (column 21, lines 15-21), and
- transmitting, to the provider from said communication device, the completed form and a verification code (e.g. data encrypted by user's key) (figures 12 and 17; column 21, lines 50-61) indicating that the generated unique identification trait and the one of the plurality of stored unique identification traits substantially match to enable the provider to verify the credit card number and the personal information contained in the completed form, verify the verification code, and carry out the transaction if the verifications are successful (figure 15; column 10, lines 1-8; column 19, lines 35-67; column 21, lines 15-21).

10. However, Krishnan et al. do not explicitly recite generating, using a biometric device, a unique identification trait associated with the person and comparing, at said biometric device, the generated unique identification trait to a plurality of unique identification traits stored in a database.

11. Shinn teaches generating a unique identification trait (e.g. fingerprint) (column 3, lines 25-39) using a biometric device (e.g. PC, laptop, PDA, ATM, etc. - column 8, lines

25-35) (figure 5; column 8, lines 25-35) and in association with acquiring a credit card number and personal information (abstract; figure 5; column 8, lines 2-25), comparing at the biometric device the generated unique trait with a previously stored trait (abstract; figure 8, column 3, lines 25-35) and if the two traits match within a specified confidence level authorizing the transaction (abstract; column 8, lines 2-25; column 10, lines 1-13). Regarding a visual or audio indication to the user to provide a biometric sample, it is inherent that such an indication would exist otherwise the user would be able to make purchases without biometric verification a scenario that teaches away from the Shinn invention. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Krishnan et al. and Shinn in order to prevent unauthorized users (such as users who have inappropriately obtained a credit card password belonging to another user- '124, figure 15, column 21, lines 2-9) from making purchases online purchases ('585, column 7, lines 24-29).

Examiner Note

12. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider the reference in its entirety as potentially teaching all or part of the claimed

invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Interpretation

13. Independent claims are examined together, since they are not patentably distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in this application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

14. Functional recitation(s) using the word "for" or other functional terms (*e.g.* "to enable the provider to verify the credit card number and the personal information contained in the completed form, verify the verification code, and carry out the transaction if the verifications are successful" as recited in claim 1) have been considered but given less patentable weight¹ because they fail to add any steps and are thereby regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

¹ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

15. Functional recitation(s) using the word “for,” “adapted to,” “operable to,” or other functional language (*e.g.* see claim 123 which recites “an input device operable to acquire at least one selection provided by a person”) have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, the Examiner has considered the functional language. However, in a product claim, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2111.04 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

16. If Applicant(s) desire to give the functional phrase(s) greater patentable weight, the Examiner respectfully recommends (by way of example only) Applicant(s) remove “for,” “adapted to,” “operable to,” or other functional language from the phrase(s) where intended use is *not* desired. For example, a hypothetical claim with a positive recitation would be ‘a computer processing the instructions’ instead of a functional recitation such as ‘a computer *for* processing the instructions’ Like always, Applicant(s) are reminded that any amendment must not constitute new matter.

17. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, **optional claim elements do not narrow claim limitations**, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Response to Arguments

18. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant is respectfully reminded that failure to comply with 37 C.F.R. §1.111(b) may result in Applicant's response being non-responsive.

Conclusion

19. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued

examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant(s) are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Because this application is now final, Applicant(s) are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted).

Furthermore, suggestions or examples of claim language provided by the Examiner are just that--suggestions or examples--and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not* been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st

paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

22. References considered pertinent to Applicant(s)' disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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